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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 23

Application Number: 09/022,132
Filing Date: February 11, 1998
Appellant(s): D'ACHARD, JOHANNES F.M.

Gregory L. Thorne, Reg. 39,398
Senior Patent Counsel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 23, 2001.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 8-22-01 has been entered, because it removes the 35 U.S.C. § 112, 2nd paragraph, rejection of claims 1 and 6 with respect to the lack of proper antecedent basis.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because it does not refer to the specification by page and line number, and to the drawings, if any, by reference

characters per Rule 192(5). The Examiner will provide a concise explanation of the invention defined in the claims on appeal below.

The invention is of simple character and nature. In sum, the invention comprises a video game network of game machines, for example, but not limited to, a pair of video arcade game machines found at the DAVE AND BUSTER'S in White Flint Mall in Rockville, MD, or any other family entertainment center. The disclosure focuses parts of game machines which are the input devices (22) for one machine and (23) for another machine; display devices (20) for one machine and (30) for the other; and cameras (26) and (36) which focus their respective lens (28) and (38) onto the respective players using input devices (22) and (23) such that the players images are captured and digitized in order to be sent to an opponent player's display, either (20) or (30), via processing devices (24) and (34) with the use of interconnection mechanism (40). See Figure 1, page 3, line 1 through page 4, line 15. Because the disclosure lacks in discussing any particular instrumentalities used in the invention disclosed within this instant application, it has been assumed by the Examiner that the "black box" equipment shown in figure 1 are off-the-shelf components, e.g. the cameras are common digital cameras available at such stores as BEST BUY or

CIRCUIT CITY, readily available to one of ordinary skill in the art at the time the invention was made.

The result of the invention is shown in figure 2. Images of the players (72) and (74) are incorporated into the game display (60) which is found on either display (20) or (30) of figure 1 during the execution of the video game program, said program's result being shown by the remaining reference numbers (62), (64), (66), (68) and (70). See figure 2, page 4, lines 5 through 15.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1 through 4 and 9 stand or fall together with claim 1 because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 6 through 8 stand or fall together with claim 6 because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,521,014	SITRICK	6-1985
4,710,873	BRESLOW	12-1987

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 through 4 and 6 through 8 rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 18.

(11) Response to Argument

At the outset, it should be noted that Appellants arguments with respect to claims 1 and 6 are not commensurate in scope with the limitations recited in claims 1 and 6. Further, the Appellants reiteration and interpretation thereof of Breslow does not take into account the entirety of the Breslow reference.

For instance with respect to the latter above, the Appellant contends that Breslow only shows the display of scores after the game as indicated by Fig. 4e. See Brief page 4, lines

18-19. However, a complete reading of Breslow, particularly col. 4, lines 19-27, 32-41 and 45-52 would indicate the following to those skilled in the art: "The previously acquired and stored game player images of the champions [the players' actually facial image] are appropriately inserted with the video graphics on the game display to position the face of each champion [player] on a respective car as the champion's cars are introduced and moved about the game display. For example in FIG. 4c, the face of the highest scoring champion (60), [i.e. the player who has the highest score] is displayed atop a car (62) formed by the video display graphics or imagery of the game apparatus.... The play of the game [game play of a particular session] starts with the six previous champions [players] and their associated cars being displayed and moved about [game play is progressing] the game display in accordance with the control by the video game apparatus [the equipment shown in figures 1-3 and 5-7].... As the six parked cars vacate their respective spaces [game play is progressing and scoring is now taking place], the game player or challenger moves the assigned care about the parking lot display via the joystick control to attempt to position the player controlled car in one of the empty parking spaces while the video game apparatus controls the six champion cars [that have their faces of these players] to

obtain one of the empty parking spaces, as shown in FIG 4d...." During game play, one of the seven cars will be eliminated, the seven include the six champions' cars or the player's car. When the player enters a parking space or is eliminated because the six champions' car got into the spaces first the game play session is over. From the reading of Breslow given above, one skilled in the art would understand that the method step argued by Appellant of "displaying ... the video image of the currently high-scoring player ... during the particular session of the video game..." is met by the Breslow reference. I.e., the displaying of the video image of the currently high-scoring player is the highest scoring champions' car which has the image of that player morphed with the car, see fig. 4c and then 4d. The later part of the limitation of said 'image being displayed during the particular session of the video game' is met by the recitation in Breslow of "[i]n one play of the game, six parked cars at random indicate that they are about to leave their respective spaces, ... As the six parked cars vacate their respective spaces, the game player ... moves ... [his or her] assigned car about the parking lot display via the joystick control to attempt to position the player controlled car in [to] one of the empty parking spaces while the video game apparatus

controls the six champion cars to obtain one of the empty parking spaces, as shown in FIG. 4d."

With respect to the Appellant's arguments not being commensurate with claim limitations it appears that Appellants perceive that the claimed limitation of "displaying ... the video image of the currently high-scoring player ... during the particular session of the video game" means only that images of players are only those players who are presently/concurrently playing in the game space with the game player. However, the claim does not have such a limitation present therein and this is why the Examiner has stated that the Appellants arguments are not commensurate in scope with the limitation of the claim recited as "displaying the gaming environment, and the video image of the currently high-scoring player of the multiple players in a prominent location, during the particular session of the video game." As stated previously before, one of the six champions' cars that include the player's image reads on "displaying the video image of the currently high-scoring player".

With respect to the Appellant's argument that the "four corners" of either Breslow or Sitrick teach showing the image and score of the highest scoring player, the "four corners" analogy is not the test for obviousness. The test for

obviousness was laid out in Graham v. John Deere which requires one to view the prior art as a whole in conjunction with the level of skill of one of ordinary skill in the art at the time the invention was made along with any secondary considerations of non-obviousness. When viewing the prior art of Breslow and Sitrick as a whole in conjunction with the level of skill of one of ordinary skill in the art at the time the invention was made, it is clear that the references find obvious displaying the image and score of the highest scoring player. For instance, in Breslow, figures 4c and 4e show, a player's image (78) and his or her score (76), while figure 4d, shows the player's score. While Sitrick discloses networking game machines and distinguishing players with difference size, color or shape, with a further suggesting using a digitized player's image, see col. 1, lines 30-49, and col. 3, lines 40-48, and each individual game machine communicating its game ID, game data, **score** to the other game machines, see col. 8, lines 18-22 as an example. Therefore, view this prior art of Breslow and Sitrick as a whole one skilled in the art would conclude that a limitation of displaying the image and score of the highest scoring player would be obvious at the time the invention was made.

With respect to the Appellant's arguments on page 5, lines 18-22, that the rejection lacks proper motivation, the rejection states one skilled in the art to be motivated to complete such a modification because said modification would provide more realism and excitement in game play. This motivation is found in the prior art where in Breslow it states incorporating player's images provides "an interactive enhancement feature", see col. 1, lines 48-49 and in Sitrick where Sitrick expresses provide a network of plural game machines avoids the confinement of the single entity concept which requires all players to be in the location for game play. Therefore the rejection's motivation of combining the references in found within the prior art which is a proper place to find said motivation.

In response to applicant's argument on page 6, lines 13-20, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to Appellant's remarks regarding the Advisory Action, the Examiner was only trying to respond to the points that the Appellant had made in the After Final Amendment of 8-22-01 which is require by the Manual of Patent Examining Procedure.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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